



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,115	01/22/2002	Kazuyuki Matsumura	0171-0813P-SP	7493

2292 7590 01/02/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

SHEWAREGÈD, BETÈLHEM

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,115

Applicant(s)

MATSUMURA ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's response filed on 10/09/2003 has been fully considered. Claim 5 is amended, and claims 1-10 are pending.

Election/Restrictions

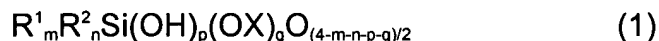
2. Applicant's election with traverse of Species A in Paper No. 8 is acknowledged. The traversal is on the ground(s) that it would not be an undue burden on the Examiner to examine both Species A and Species B. This is not found persuasive because Species A and Species B are distinct species, and searching for two distinct species requires two different strategies, which in turn put an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaya et al. (EP 0 841 355 A2).

Yamaya discloses an article comprising a paper substrate (page 15, line 39) coated with an emulsion composition comprising component (1) 100 parts by weight of a water-insoluble silanol group-bearing silicone resin of formula (1):



Wherein R^1 is unsubstituted monovalent hydrocarbon group preferably those having 1-10 carbon atoms (page 6, line 1), R^2 is a substituted monovalent hydrocarbon group preferably those having 1-10 carbon atoms (page 6, line 9), X is a monovalent hydrocarbon group having 1-6 carbon atoms (page 6, line 27), letters m, n, p and q are numbers satisfying $0.5 \leq m \leq 1.8$, $0 \leq n \leq 1.0$, $0 < p \leq 1.5$, $0 \leq q \leq 0.5$, $0.5 \leq m+n \leq 1.8$, and $0 < p+q \leq 1.5$, and component (2) 10 to 1,000 parts by weight of a radical polymerizable vinyl monomer (page 3, lines 39-53). Component (1) is equivalent to the claimed component (a-1) and component (2) is equivalent to the claimed component (b).

Response to Arguments

4. Applicant argument is based on that the reference of Yamaya fails to disclose an ink jet printing paper obtained by coating cellulose fibers of paper upon paper making. The argument is not persuasive because Yamaya discloses the use of paper as the substrate to apply the above coating solution on at least one of the surfaces (see page 15, lines 38-41). It is notoriously known that paper comprises cellulose fibers. Yamaya also discloses wood as the substrate to apply the above coating solution on at least one of the surfaces (see page 15, lines 38-41). It is also notoriously known that wood comprises cellulose fibers. Therefore, Yamaya disclose all of the elements of the instantly claimed invention. For the above reasons claims 1 and 2 stand rejected and claims 3-8 are also included in the rejection.

Art Unit: 1774

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 10/051,115

Page 5

Art Unit: 1774

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'B. Shewareged'.

Betelhem Shewareged
December 23, 2003.